

REMARKS

The Specification and Claims 1, 19, 20, 24, 32 and 33 have been amended for clarification purposes only, and thus, such amendments do not present new matter. Claim 27 has been amended to recite an allowed limitation. No claims have been canceled or added. Thus, claims 1-33 are pending in the case. Further examination and reconsideration of the presently claimed application is hereby respectfully requested.

Objection to the Specification:

The Specification was objected for an informality. In particular, the Abstract was objected to for including the title of the invention on the same page as the Abstract. To expedite prosecution, the Specification has been amended in a manner that addresses the concerns expressed in the Office Action. Accordingly, removal of the objection to the Specification is respectfully requested.

Section 102 Rejections:

Claims 27, 28 and 29 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,584,466 to Serbinis et al. (hereinafter "Serbinis"). The standard for "anticipation" is one of fairly strict identity. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP 2131. Serbinis does not disclose all limitations of the currently pending claims, some distinctive limitations of which are set forth in more detail below.

Serbinis does not disclose a computer-usable carrier medium comprising a set of program instructions that are executable on a computer for displaying a graphical user interface, which includes representations of multiple communications applications accessible with the computer and representations of multiple potential participants in a communications session. Amended independent claim 27 recites, in part, "[a] computer-usable carrier medium, comprising... a set of program instructions executable on a computer for displaying a graphical user interface including representations of multiple communications applications accessible with the computer and representations of multiple potential participants in the communications session." Claim 27 was amended to include a limitation that

is recited in allowed claim 24. Independent claim 30 and dependent claim 19 recite similar limitations.

Serbinis discloses an internet document management system and methods (Serbinis, Title). Serbinis, however, does not disclose a computer-usable carrier medium comprising a set of program instructions that are executable on a computer for displaying a graphical user interface, which includes representations of multiple communications applications accessible with the computer and representations of multiple potential participants in the communications session, as recited in present claim 27.

With regard to present claims 19 and 30, statements in the Office Action suggest that Serbinis does disclose a system and method for displaying a graphical user interface ("GUI"), which includes representations of multiple communications applications accessible with the computer and representations of multiple potential participants in the communications session. As evidence for the alleged disclosure, the Examiner summarizes column 5, lines 1-10 of Serbinis in stating, "a user enters information into a form displayed in a web browser, in which the information is transferred to server computer 20 using http and is made available to the programmed routines executing on server computer 20 through the common gateway interface" (Office Action, pages 9 and 11-12). As such, the Examiner appears to suggest that a web browser, which may include a form for receiving user-entered information, is somehow equivalent to the graphical user interface recited in original claims 19, 24 and 30 and amended claim 27. The Applicant respectfully disagrees, for at least the reasons set forth in more detail below.

The Applicant agrees that a user may enter information into a form that is displayed in a web browser (the alleged "GUI") of Serbinis. However, such disclosure does not and cannot anticipate the aforementioned limitation of present claim 27. First of all, merely stating that a user may enter information into a form displayed on a web browser does not indicate that the web browser may also include "representations of multiple communications applications accessible with the computer and representations of multiple potential participants in the communications session", as recited in present claim 27. In addition, the form disclosed by Serbinis cannot be considered equivalent to the presently claimed "representations" of multiple communications applications and potential participants, since the function of a form is to receive user-entered information rather than to represent existing information. Serbinis simply fails to disclose the use of "representations" within a GUI, and therefore, cannot anticipate all limitations of present claim 27.

For at least the reasons set forth above, Serbinis fails to anticipate all limitations of independent claim 27. Therefore, claim 27 is asserted to be patentably distinct over the cited art. Since claims 28 and 29 are dependent from claim 27, claims 28 and 29 are patentably distinct over the cited art for at least the same reasons as claim 27. Accordingly, removal of the §102 rejections of claims 27-29 is respectfully requested.

Section 103 Rejections:

Claims 1, 7, 8, 11-19, 21-23, 26 and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Serbinis. To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. *In re Bond*, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). Serbinis does not teach or suggest all limitations of the currently pending claims, some distinctive limitations of which are set forth in more detail below. Therefore, the §103 rejection of claims 1, 7, 8, 11-19, 21-23, 26 and 30 is hereby respectfully traversed.

Serbinis does not disclose a system (claims 1 and 13), computer-usable carrier medium (claim 22), or method (claim 30) for receiving, from a user, notification of a desired communications application to be used in a communications session. Amended independent claim 1 states, in part, "[a] method of establishing a computer-based communication session involving a user of a computer, said method comprising: receiving, from the user, notification of a desired participant in the communication session and a desired communications application to be used for the session...". Independent claim 1 has been amended only to include punctuation, and thus, the amendments to claim 1 do not introduce new matter. Independent claims 13, 22 and 30 recite similar limitations and remain in their original state.

Serbinis discloses "an Internet-based document management system and methods wherein an electronic document may be stored on an Internet-accessible server and accessed using a previously known web browser, downloaded for review or manipulation, and then returned to the server for access by further users." (Serbinis, column 3, lines 15-20). Serbinis, however, does not teach or suggest a system, computer-usable carrier medium, or method for receiving, from a user, notification of a desired communications application to be used in a communications session, as recited in claims 1, 13, 22 and 30.

Instead of receiving notification from a user of a desired communications application to be used in a communications session, Serbinis discloses a system and method by which users may receive notification messages from a notification server to inform the users of the availability of a document or the delivery of a notification message. For example, Serbinis discloses, "notification server 35 generates notification messages to the Authorized Users informing those Users that the document is available in store 30." (Serbinis, column 9, lines 50-52). Serbinis also discloses that the "notification server... may provide a notification to the Originator that the notifications to the Authorized Users have been sent or delivered..." (Serbinis, column 9, lines 52-55). As such, the only notification messages disclosed by Serbinis are sent from notification server 35, and thus, are not sent from a user (e.g., an Originator or Authorized User), as recited in present claims 1, 13, 22 and 30. In addition, the only notification messages disclosed by Serbinis are used to inform Authorized Users of the availability of a document and/or to inform the Originator of the delivery of a notification message. Therefore, the notification messages of Serbinis do not provide notification of a desired communications application to be used in a communications session, as recited in present claims 1, 13, 22 and 30. Consequently, Serbinis does not teach or suggest all limitations of claims 1, 13, 22 and 30.

In fact, the Examiner admittedly states, "Serbinis does not explicitly disclose..." a system [claims 1 and 13], computer-usable carrier medium [claim 22] or a method [claim 30] for receiving "...a desired communications application to be used for the session." (Office Action, pages 5, 7, 10 and 12). However, the Examiner suggests that "Serbinis discloses users initiate user sessions to retrieve the document, including any specified automatic or user selected filtering requested for the document, for example, [to] electronically distribute a copyrighted book, permitting users who pay for the book to access and download the book, (see col. 10, lines 49-54)", and as such, "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Serbinis with a desired communications application to be used for the session." (Office Action, pages 5, 7-8, 10-11 and 12-13). The Applicants respectfully disagree with the Examiner's motivation for modifying the invention of Serbinis, as set forth in more detail below.

In the above statement, the Examiner appears to suggest that it would be obvious to modify the teachings of Serbinis to include the presently claimed step of receiving, from a user, notification of a desired communications application to be used in a communications session, simply because Serbinis discloses a document retrieval service that "could be used, for example, to electronically distribute a

copyrighted book, by permitting users who pay for the book to access and download the book.” (Serbinis, column 10, lines 49-54). However, the passage cited by the Examiner does not provide sufficient motivation for modifying the invention of Serbinis to receive notification from a user of a desired communications application to be used for retrieving a document (or for distributing a copyrighted book). For example, the cited passage does not suggest that the document may be retrieved using more than one communications application. As such, the cited passage provides absolutely no motivation for a user to send notification of a desired communications application to be used in retrieving the document. As a consequence, it would be improper to modify the teachings of Serbinis in light of the passage cited by the Examiner.

In addition to the passage cited by the Examiner, no motivation can be found within any other portion of Serbinis, which would allow one skilled in the art to modify the invention of Serbinis to include the presently claimed step of receiving, from a user, notification of a desired communications application to be used in a communications session. For example, Serbinis discloses only one communications application – a web browser – that can be used for a user session (i.e., a “communication session” created, e.g., for retrieving a document). Unlike the presently claimed case, Serbinis fails to suggest a desirability for using other communication applications for conducting the user session. See, e.g., Serbinis column 2, lines 46-51 and column 9, lines 15-67. As set forth in MPEP 2143.01, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination or [modification]. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Since Serbinis fails to suggest a desirability for including the presently claimed step of receiving, the invention of Serbinis cannot be modified to teach or suggest all limitations of present claims 1, 13, 22 and 30.

In anticipation of the Examiner’s response, the Applicant wishes to point out that the means (e.g., e-mail, facsimile, voice or pager) used for sending notification messages are not used for conducting the user sessions of Serbinis. In addition to the lack of disclosure, Serbinis also fails to suggest a desirability for conducting user sessions via other communication applications, such as e-mail, facsimile, voice or pager. Furthermore, even if Serbinis were somehow modified to conduct user sessions via alternative communication applications (without sufficient disclosure or desirability for doing so), the modified invention of Serbinis could be rendered unsatisfactory for its intended purpose. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no

suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

For example, Serbinis explicitly states, "[i]t is another object of the present invention to provide an Internet-based document management system and methods that permit users to collaboratively store, retrieve, modify and then return an electronic document to an Internet-based storage site." (Serbinis, column 2, lines 52-57). It is highly unlikely that a user would be able to modify a document that is retrieved via most, if not all, of the alternative communication applications described above. Therefore, the invention of Serbinis would most likely be unsatisfactory for its intended purpose if the invention were modified to conduct user sessions through one of the alternative communication applications disclosed for sending notification messages. Consequently, Applicant's assert that there is no motivation to make the proposed modification to the invention of Serbinis.

For at least the reasons set forth above, Serbinis does not teach, suggest or provide motivation for all limitations of independent claims 1, 13, 22, and 30. Therefore, independent claims 1, 13, 22, 30, and all dependent claims therefrom, are patentably distinct over the cited art. Accordingly, removal of the §103 (a) rejection of claims 1, 7, 8, 11-19, 21-23, 26 and 30 is respectfully requested.

Allowable Subject Matter:

Claims 2-6, 9, 10, 20, 24, 25 and 31-33 were objected to for being dependent upon rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant sincerely appreciates the Examiner's recognition of the patentable subject matter recited in claims 2-6, 9, 10, 20, 24, 25 and 31-33 and awaits allowance of the remaining claims in the case. The Office Action states some reasons for allowance of claims 2-6, 9, 10, 20, 24, 25 and 31-33 in the section of the Office Action entitled "Allowable Subject Matter". Applicant asserts that it is the combinations of features in these claims that render the claims distinguishable over the cited art, not just the portions of the claims cited in the Office Action.

CONCLUSION

In the present response, the Specification and Claims 1, 19, 20, 24, 32 and 33 have been amended for clarification purposes only, and thus, such amendments do not present new matter. Claim 27 has been amended to recite a limitation from an allowed claim. In addition, the §102 rejection of claims 27-29 and the §103 rejection of claims 1, 7, 8, 11-19, 21-23, 26 and 30 have been addressed. Furthermore, the prior art made of record but not relied upon is not believed to be pertinent to the patentability of the present claims. This response, therefore, constitutes a complete response to all issues raised in the Office Action mailed January 14, 2004. In view of the remarks traversing rejections, Applicants assert that pending claims 1-33 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Conley Rose, P.C. Deposit Account No. 50-1505/5468-08500/KLD.

Respectfully submitted,

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